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| AUG 3 0 2005 | RANSMITTA | ${f L}$ | Filing Date | March 2, 2004 |
| ADEMARK OF S | FORM | | First Named Inventor | Ori Eisen |
| (to be u | sed for all correspondence after in | sitial filing) | Art Unit | 3621 |
| | | | Examiner Name | Not Yet Assigned |
| Total Numbe | er of Pages in This Submission | 23 | Attorney Docket Number | 31718-701.201 |
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| | Fee Attached | Licensin | g-related Papers | Appeal Communication to Board of Appeals and Interferences |
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| Express | Abandonment Request | Request f | or Refund | (please identify below): 1. Amended Figure 1 |
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| his collection of infor | mation is required by 37 CFR 1.5. The | 110 110 | . Date | August 30, 2005 |

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450,

If you need assistance in completing the form, call J-800-PTO-9199 and select option 2.

FACSIMILE (571) 273-8300 PATENT DOCKET NO.: 31718-701.201 AUG 3 0 2005 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE Patent Application of Applicant(s): Ori Eisen Art Unit: 3621 Best Available Cop Serial No.: 10/791,439 Examiner: Not Yet Assigned Filed: March 2, 2004 Confirmation No.: 3435 Title: METHOD AND SYSTEM FOR IDENTIFYING USERS AND DETECTING FRAUD BY USE OF THE INTERNET Mail Stop Petitions Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

<u>SUPPLEMENTAL (EXPEDITED) PETITION TO EXPUNGE</u> PART OF ORIGINAL DISCLOSURE (37 C.F.R. § 1.183)

Sir:

Applicant hereby submits this Supplemental Petition to be considered together with the Expedited Petition to Expunge Part of Original Disclosure / Suspend the Rules under 37 C.F.R. § 1.183 filed on August 25, 2005 (the "Original Petition"). These petitions request waiver of the requirements of 37 C.F.R. § 1.59(a) and their expedited consideration is respectfully requested.

The chart containing personal information submitted as part of the instant patent application (the "Chart") contains personal information that was filed as part of the original disclosure on March 2, 2004. Applicant previously submitted substitute sheets entitled "Figure 1" in the Original Petition for immediate entry into the record in place of the Chart, if possible. However, upon further consideration of Figure 1 and its contents, Applicant hereby submits amended substitute sheets ("Amended Figure 1") in the alternative. Amended Figure 1 redacts or removes portions of the Chart, and does not introduce new text that could be possibly construed as new matter. All other remedial actions deemed necessary to prevent public disclosure of the Chart and its contents is again respectfully requested.

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The basis for this petition under 37 C.F.R. § 1.183 and why justice requires suspension of the rules (37 C.F.R. § 1.59(a)) in this extraordinary situation are provided below.

REMARKS

The instant patent application is related generally to electronic commerce (e-commerce) transactions and solutions for identifying computers, particularly those associated with fraudulent online transactions. In order to explain concepts of the invention provided herein, it was intended for the Chart to include information about fictional online users including phony names, e-mail address, credit card information. Whether the underlying information in the Chart is fictitious or not adds no real value for purposes of describing and explaining the concepts of the invention. References to the Chart in this application are as follows:

- 1. In the last paragraph on p. 5 of the patent application (five lines from the bottom of the page), the following reference is made to the Chart "Referring to the chart, what is shown is a series of typical transactions on the Internet between a merchant and several customers."
- 2. Under the section entitled "Brief Description of the Chart," the following reference is made to the Chart "The chart illustrates the versatility and accuracy of the present invention in weeding out possible fraudulent online transactions."

Applicant contends that Amended Figure 1 submitted herewith includes redacted portions of the entries submitted in the original Chart, and therefore does not introduce new matter. The first or last names of individuals have been deleted in the Amended Figure 1 without the addition of any new text. Moreover, the "domain" portions of e-mail addresses from the Chart have also been replaced with the "local-part" or the name of an individual which precede the "@" symbol, e.g., Bob@bob.com. Finally the partial credit card numbers remain crossed-out (X) entirely. As explained above, none of the details in of the Chart is necessary to describe and claim the invention as required under applicable patent statutes and rules.

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CONCLUSION

Because information forming part of the original disclosure may not be expunged as stated under 37 C.F.R. § 1.59(a) in general, Applicant hereby requests suspension of the rules pursuant to 37 C.F.R. § 1.183. Based upon inspection of the record and papers submitted to date, the instant petition should be granted. Applicant respectfully requests that:

- (1) the Chart be expunged from the original disclosure and that it not be published or otherwise disclosed to the public such as by inspection of the physical files or the PAIR access site; and
- (2) Figure 1 be entered into the record in place of the Chart, or in the alternative, entry of Amended Figure 1 is requested should there be any concerns regarding introduction of new matter. Favorable and prompt action on this expedited request is respectfully solicited in this extraordinary situation.

The Commissioner is hereby authorized to charge applicable fees as required by 37 C.F.R. § 1.17(h) or for expedited consideration of this petition or the Original Petition, and any other additional fees or credit any overpayment associated with this communication to Deposit Account No. 23-2415 (Docket No.: 31718-701.201).

Respectfully submitted;

WILSON SONSINI GOODRICH & ROSATI Professional Corporation

Dated: August 30, 2005

U. P. Peter Eng Registration No.: 39,666

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I hereby certify that this correspondence is being facsimile transmitted and/or deposited with the U.S. Postal Service as first class mail to the United States Patent and Trademark Office on 8/30/05

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| | CORK | | | | | | ug. |
| | CORK | MOZILLA4.0 (COMPATIBLE; MSIE 5.0; WINDOWS 98; DIGEXT) | GABRIEL@GABRIEL.COM | | 08-Feb-02 | 603 | 30 |
| | | (COMPATIBLE; MSIE | GABRIEI @GABRIEL.COM | 09-Feb-02 | 08-Feb-02 | 603 | . 2 |
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| | CORK | COMPATIBLE; MSIE | GABRIEL@GABRIEL.COM | • | 08-Feb-02 | 602 | |
| - | CORK | (COMPATIBLE; MSIE 5.0; WINDOWS | GABRIEL GABRIEL COM | 09-Feb-02 | 08-Feb-02 | 82 | |
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| | CORK | (COMPATIBLE | GABRIEL@GABRIEL.COM | 09-Feb-02 | 08-Feb-02 | 80 i | ON |
| | CORK | (COMPATIBLE: MOIE 5.0; WINDOWS | GABRIEL@GABRIEL.COM | 09-Feb-02 | 08 Ech 03 | 3.5 | |
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| | CORK | NO. | GABRIEL GABRIEL COM | 09-Feb-02 | 08-Feb-02 | 802 | NS |
| | | (COMPATIBLE: MSI | GABRIEL COM | 09-Feb-02 | 08-Feb-02 | 8 8 | 311 |
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| | CORK | (COMPATIBLE: MSIE 5.0; WINDOWS 98; | GABRIEL@GABRIEL.COM | 09-Feb-02 | 08-Feb-02 | 200 | |
| | | MSIE | GABRIEL @GABRIEL COM | .09-Feb-02 | 08-Feb-02 | 602 | |
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| | | | GABRIEL@GABRIEL.COM | :: 09-Feb-02 | 08-Feb-02 | 80 80 80 80 80 80 80 80 80 80 80 80 80 8 | , |
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| | CORK | (COMPATIBLE; MSIE 5.0; | GABRIEL @GABRIEL COM | 09-Feb-02 | 08-Feb-02 | 602 | |
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| | | (COMPATIBLE MSIE | GABRIEL WGABRIEL COM | 09-Feb-02 | 08-Feb-02 | 602 | |
| | _ | COMPATIBLE: MSIE | GABRIEL@GABRIEL.COM | 09-Feb-02 | 08-Feb-02 | 8 8 8 | |
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| | | (COMPATIBLE: MOLE | GABRIEL@GABRIEL.COM | 09-Feb-02 | 08-F60-02 | £ 6 | No |
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| | _ | | GABRIEL@GABRIEL.COM | 09-Feb-02 | 08-Feb-02 | 88 | 5 |
| | • | (COMPATIBLE: MSIE 5.0; WINDOWS 98; | GABRIEL@GABRIEL COM | 09-Feb-02 | 08-Feb-02 | 602 | |
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| • | _ | MOZILLA/4.0 (COMPATIBLE; MSIE 5.0; WINDOWS OR- DICEYTY | GABRIEL @GABRIEL COM | 09-Feb-02 | 08-Feb-02 | 603 | 12 |
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| XXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXX | | (COMPATIBLE; MSIE 5.0; WINDOWS 98; DIGEXT) | GABRIEL @GABRIEL COM | 09-Feb-02 | 08-Feb-02 | 6 03 | 30. |
| XXXXXXXXXXXXXXX | CORK | (COMPATIBLE; MSIE 5.0; WINDOWS 98: DIGEXT) | GABRIEL@GABRIEL.COM | 09-190-02 | 08-Feb-02 | 603 | 2 |
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| XXXXXXXXXXXXXXXXXX | | (COMPATIBLE: MASE 5 O: WINDOWS 98; DIGEX!). | GABRIEL@GABRIEL.COM | 09-Feb-02 | 08 E 24 02 | 200 |)5 |
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| XXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXX |)RK | (COMPATIBLE: NISIE 5.0; WINDOWS 98; DIGEXT) | GABRIEL@GABRIEL.COM | 09-Feb-02 | U8-Feb-02 | 503 | 1 |
| XXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXX | XX. | (COMPATIBLE: Male 3.0; WINDOWS 98; DIGEXT) | GABRIEL@GABRIEL.COM | 09-Feb-02 | 08-Feb-02 | 303 | . • |
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| FIG. 1 | WINDOWS 98; WINDOWS 98; | MOZILLA/4.0 (COMPATIBLE; MSIE 5.0; WINDOWS 98; DIGEXT) MOZILLA/4.0 (COMPATIBLE; MSIE 5.0; WINDOWS 98; DIGEXT) | WINDOWS 98 | (COMPATIBLE MSIE | WINDOWS 98 | MOZILLA4,0 (COMPATIBLE, MSIE 5.0; WINDOWS 98; DIGEXT) | 8 | MOZILLA/4.0 (COMPATIBLE; MSIE 5:0; WINDOWS 98; DIGEXT) | 98- | MOZILLA/4.0 (COMPATIBLE; MSIE 5.0; WINDOWS 98; DIGEXT) | 8 | MOZILLA/4.0 (COMPATIBLE; MSIE 5.0; WINDOWS 98; DIGEXT) | 88 | MOZILLA/4.0 (COMPATIBLE; MSIE 5.0; WINDOWS 98; DIGEXT | MOZILLA/4.0 (COMPATIBLE: MISTERS OF WINDOWS 98; DIGEXT | 8 | MOZILLAVA.0 (COMPATIBLE: MSIE 5.0: WINDOWS 98: DIGEXT | MOZILLA/4.0 (COMPATIBLE MSIE 5.0; WINDOWS 98; DIGEXT) | (COMPATIBLE, MSIE | MOZILLA/4.0 (COMPATIBLE: MSIE 5.0: WINDOWS 98; DIGEXT) | MSIE | MOZILLA/4.0 (COMPATIBLE: MSIE 5.0; WINDOWS 98; DIGEXT) | MOZILLA/4.0 (COMPATIBLE; MSIE 5.0; WINDOWS 98; DIGEXT) | MOZILLA/4.0 (COMPATIBLE, MSIE 5.0; WINDOWS 98; DIGEXT) | MOZILLA/4.0 (COMPATIBLE; MSIE 5.0; WINDOWS 98; DIGEXT) | MOZILLA/4.0 (COMPATIBLE; MSIE 5.0; WINDOWS 98; DIGEXT) | WINDOWS | (COMPATIBLE; MSIE 5.0; WINDOWS | (COMPATIBLE: MSJE 5.0; WINDOWS 98; | WINDOWS 98 | MOZILLA/4.0 (COMPATIBLE; MSIE 5.0; WINDOWS 98: DIGEXT) | |
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| | | | FIG. 1 | | S S | | PortbNPALIB | ≟Au |
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| XXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXX | : | 5.0; WINDOWS 98; DIGEXT) | (COMPATIBLE: MAIE | PATRIC@PATRIC.COM | 17-Heb-02 F | 70-02 | 1 | 30 |
| XXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXX | | 5.0, WINDOWS 98; DIGEXT) | COMPATIBLE: MOIE | PATRIC@PATRIC.COM | | 17-Ech 03 | 592 |). |
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| XXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXX | SIMON | S.O. YVIINDOVYS 98; DIGEXT) | COMPATIBLE LANGE | FAIRIC@PATRIC.COM | 20-d8-1-1 | 1000 | 7 (C) | |
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| | | 5.0; WINDOWS 98; DIGEXT) | COMPATIBLE | PATRIC@PATRIC.COM | 17-Feb-02 | 77-rep-02 | 5 6 5 7 | |
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| XXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXX | | E 50, WINDOWS 98; DIGEXT) | COMPATIBLE, | PATRIC@PATRIC.COM | 17-Feb-02 | 17 Eph 00 | 502 | |
| XXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXX | SIMON | ין כי | COMPATIBLE: | PAIRIC@PATRIC.COM | 70-den-02 | 17 Feb 02 | 70 i | |
| XXXXXXXXXXXXXXXX | | S.O. WINDOWS SS | (COMPATIA) = | PATRIC COM | 17-Teb-02 | 17-Feb-03 | 597 | |
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| | ANNA | | COMPATIBLE; | PETER@PETER COM | | 16-Feb-02 | 594 | |
| VXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXX | ANNA | | COMPATIBLE | PETER@PETER.COM | 17-Feb-02 | 10-Feb-02 | T. 0 | |
| * XXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXXX | ,; ; | 5.0. WINDOWS 98; DIGEXT) | | PETER@PETER.COM | 17-Feb-02 | 10-7-02-02 | 7 C | |
| | ANNA | OU WINDOWS 98; DIGEXT) | COMBATIBLE. | PETER@PETER.COM | 17-Feb-02 | | 5 (C) | |
| • | 3., | WINDOWS 96, DIGEXT) | COMPATIBLE: | THE HARDETER.COM | (7 Feb-02 | 18 Feb.03 | 594 | |
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| XXXXXXXXXXXXXX | WALLACE | | ijΪ | YEHIA@YEHIA.COM | 10-rep-02 | 17-6-03 | 598 | Р. |
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| CARD NUMBE | CARD HOLDER | 3 | MOZILLA/4.0 (COMPATIBLE: MO | PATRIC@PATRIC.COM | 17 Feb-02 | 17-Feb-02 | 592 | 8 |
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| II FortbnPALIB1\LCV\2696289_2.DOC | | 28-Jun-02 | 29-May-02 | 29-May-02 | 29-May-02 | 29-May-02 | 09-Jun-02 | 09-Jun-02 | .09-Jun-02 | 21-May-02 | 24-May-02 | 24-May-02 | 07-May-02 | 18-Apr 03 | 18 Apr-02 | 18-Apr-02 | 18-Apr-02 | 18-Apr-02 | 18-Apr-02 | 18-Apr-02 | 25-Apr-02 | 25-Apr-02 | 08-Apr-02 | 25-Apr-02 | 18-Apr-02 | 18-Apr-02 | 18-Apr-02 | 18-Apr-02 | 18-Apr-02 | 18-Apr-02 | 18-Apr-02 | 18-Apr-02 | 18-Apr-02 | 19-Apr-02 | 19-Apr-02 | 11-Apr-02 | 11-Apr-02 | Š | |
| P.DOC | | 29-Jun-02 | 29-May-02 | 30-May-02 | 30-May-02 | 29-May-02 | 10-Jun-02 | 10-Jun-02 | 10-Jun-02 | 21-May-02 | 25-May-02 | 25-May-02 | 07-May-02 | 07-May-02 | 07-May-02 | 07-May-02 | 07-May-02 | 07-May-02 | 07 Tay-02 | 19/Apr-02 | 19-Apr-02 | 19-Apr-02 | 19-Apr-02 | 19-Apr-02 | 19-Apr-02 | 19-Apr-02 | 19-Apr-02 | 26-Apr-02 | 26 Apr 02 | 26-Apr-02 | 26-Apr-02 | 19-Apr-02 | 19-Apr-02 | 19-Apr-02 | 19-Apr-02 | 19-Apr-02 | 19-Apr-02 | 19-Apr-02 | 19-Apr-02 | 19-Apr-02 | 19-Apr-02 | 19-Apr-02 | 12-Apr-02 | 17-Feb-02 | | CUSTLOCAL |
| | | YAKOOB@YAKOOB.COM | TMAIL COM | LINA @LINA.COM | LINA@LINA.COM | COM | CUTIE@CUTIE:COM | CUTIE@CUTIE COM | CUTIEMCHTIE COM | M . | M | M. | BT · | BT | B | BT - | 01 | | 2 | AHMED@AHMED.COM | AHMED@AHMED.COM | AHMED@AHMED.COM | AHMED@AHMED.COM | AHMED@AHMED.COM | AHMED@AHMED COM | AHMED BAHMED COM | ALMED ALLER COM | ATTITION ATTITUDE COM | | IATTITUDE@IATTITUDE COM | IATTITUDE@IATTITUDE.COM? | AHMED@AHMED.COM | ATMITTO ATMITTO COM | ALMIDONELLID COM | AHMED COM | AHMED@AHMED.COM | AHMED@AHMED.COM | AHMED@AHMED.COM | AHMED@AHMED.COM | AHMED@AHMED.COM | LCOM | I COM | NETA WIEHA COM | | EMAIL | ~ |
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DOCKET NO.: 31718-701.201

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit: 3621

Examiner: Not Yet Assigned

Confirmation No.: 3435

In re Patent Application of Applicant(s): Ori Eisen

Serial No.: 10/791,439

Filed: March 2, 2004

Title: METHOD AND SYSTEM FOR **IDENTIFYING USERS AND** DETECTING FRAUD BY USE OF THE INTERNET

Mail Stop Petitions

Commissioner for Patents Best Available

P.O. Box 1450

Alexandria, VA 22313-1450

(EXPEDITED) PETITION TO EXPUNGE PART OF ORIGINAL DISCLOSURE (37 C.F.R. § 1.183)

Sir:

Applicant hereby petitions to suspend the rules under 37 C.F.R. § 1.183 in order to expunge a chart containing personal information (the "Chart") from the disclosure originally filed in this application. This petition requires a waiver of the requirements of 37 C.F.R. § 1.59(a). Expedited consideration of this petition is respectfully requested.

The Chart in the instant patent application contains personal information that was filed as part of the original disclosure on March 2, 2004. Applicant respectfully requests that the present petition be granted, and hereby submits a substitute sheet entitled "Figure 1" to replace the Chart in the event the substitute sheet can be immediately entered into the record following consideration of this petition. In the alternative, Applicant requests permission to submit the substitute sheet later during prosecution for consideration by the responsible Examiner. Applicant further requests that the originally filed Chart be made not available to the public and non-viewable on the Public Patent Application and Information Retrieval (PAIR) access site.

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U.S. Sexial No.: 10/791,439 Docket No.: 31718-701.201

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Other remedial actions that may become necessary to prevent public disclosure of the Chart and its contents is also respectfully requested.

The basis for this petition under 37 C.F.R. § 1.183 and why justice requires suspension of the rules (37 C.F.R. § 1.59(a)) in this extraordinary situation are provided below.

REMARKS

The instant patent application entitled "Methods and Systems for Identifying Users and Detecting Fraud by Use of the Internet" was filed on March 2, 2004. miscommunication between the applicant inventor Ori Eisen and his attorney, this submission included a Chart containing personal information and partial excerpts of non-fictitious information for non-fictitious persons. The Chart unfortunately contains real names of people, their respective e-mail addresses, and partially redacted credit card numbers.

There is nothing in the record that supports the need for the kinds of private information included in the originally filed Chart: The instant patent application is related generally to electronic commerce (e-commerce) transactions and solutions for identifying computers, particularly those associated with fraudulent online transactions. In order to explain concepts of the invention provided herein, it was intended for the Chart to include information about fictional online users including phony names, e-mail address, credit card information. Whether the underlying information in the Chart is fictitious or not adds no real value for purposes of describing and explaining the concepts of the invention in the instant application. Meanwhile, the magnitude of possible harm in the event the originally filed Chart were to be published is significant. This was an inadvertent error committed during the filing of the instant patent application and the Chart must be expunged from the record in the interests of justice.

Below are facts that are believed to be relevant to this petition:

- The instant patent application (Patent Application Serial No. 10/791,439) was filed on March 2, 2004.
- The patent application as filed contained fourteen (14) pages including claims, and also an additional enclosure identified as "Chart" in the application transmittal. April 18 Mars
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- 3. The application transmittal further included a Request for Non-Publication pursuant to 35 U.S.C. 222(b)(2) and was not the subject of an application filed in another country requiring publication of the application 18 months after filing of the application.
- 4. The originally filed Chart consists of forty-two (42) pages contains numerous dates, e-mail addresses, names and partially redacted credit card numbers.
- 5. The Chart appears to be a printout from an Excel document with improper pagination whereby columns run-off the letter sized spreadsheet configured with a portrait-style layout.
- 6. In the last paragraph on p. 5 of the patent application (five lines from the bottom of the page), the following reference is made to the Chart "Referring to the chart, what is shown is a series of typical transactions on the Internet between a merchant and several customers."
- 7. Under the section entitled "Brief Description of the Chart," the following reference is made to the Chart "The chart illustrates the versatility and accuracy of the present invention in weeding out possible fraudulent online transactions."

A review of the Chart and its contents clearly demonstrates that it was unintentionally submitted. The printout and format of the Chart further lends support to the conclusion that it was submitted by mistake in that the pagination error caused the Chart to nearly triple in length. Moreover, the transaction information provided in the Chart was provided to serve as exemplary transactions in which fraud could be detected in accordance with the invention. Applicant contends that none of the content provided in the Chart is necessary to describe and claim the invention as required under applicable patent statutes (Title 35 U.S.C.) and governing rules, nor is such information material to patentability or would otherwise be considered important by a reasonable examiner.

This error was only recently uncovered during the inspection of the file for this application by new counsel for Applicant. A Power of Attorney for new counsel was filed on June 20, 2005. Upon recent inspection of the record to confirm the inadvertent filing of the Chart, Applicant is diligently filing this petition to expunge. Furthermore, because Applicant requested non-publication of the patent application under 35 U.S.C. 222(b)(2), this application is not currently scheduled for publication. In the event a patent issues from this patent application, or if Applicant decides to withdraw the non-publication request, the interests of justice require C.INIPORDALIBIUCV2711703_LDOC

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that the Chart be expunged from the record. Because information forming part of the original disclosure may not be expunged as stated under 37 C.F.R. § 1.59(a) in general, Applicant hereby requests suspension of the rules pursuant to 37 C.F.R. § 1.183 in this instance.

Based upon these facts and inspection of the originally filed patent application, Applicant's petition should be granted. Applicant requests that the Chart be expunged from the original disclosure and that it not be published or otherwise disclosed to the public such as by inspection of the physical files or the PAIR access site. Favorable and prompt action on this expedited request is respectfully solicited in this extraordinary situation.

The Commissioner is hereby authorized to charge the fee of \$ 130.00 as required by 37 C.F.R. § 1.17(h), the fee of \$ 400.00 for expedited consideration of this petition, and any other additional fees or credit any overpayment associated with this communication to Deposit Account No. 23-2415 (Docket No.: 31718-701.201).

Respectfully submitted,

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Dated: August 25, 2005

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